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Paper No. 9

COPY MAILED

DEC 12 2002

In re Application of: :
Liban Yusuf :
Application No. 09/752,988 :
Filed: January 2, 2001 : DECISION REFUSING STATUS
Title of Invention: LOTTERY : UNDER 37 CFR 1.47(b)
TICKET PLAY ACTION GAME :

OFFICE OF PETITIONS

This is a decision on the Petition under 37 CFR 1.47(b), filed September 7, 2001, to allow the assignee to proceed with the application on behalf of and as agent for all inventors. The delay in treating this petition is regretted.

The petition is dismissed.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO RESPOND WILL RESULT IN THE ABANDONMENT OF THIS APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.47(b)."

The above-identified application was filed on January 2, 2001, without a fully executed oath or declaration. A Notice to File Missing Parts of Nonprovisional Application (hereinafter "Notice") was mailed on March 6, 2001, noting, in relevant part, the above deficiency.

In response, Petitioner files the instant petition wherein Petitioner avers that a letter, along with a Declaration and Power of Attorney and Assignment in connection with this application were sent to the inventor, who failed to return the documents, and refused to return telephone messages left on the inventor's answering machine.

A grantable petition under 37 CFR 1.47(b) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration; (2) an acceptable oath or declaration; (3) the petition fee; (4) a statement of the last known address of the non-signing inventor(s); (5) proof of proprietary interest; and (6) proof of irreparable damage. Rule 47(b) applicant lacks items (1), (2), (5) and (6), set forth above.

As to item (1), the applicant has failed to establish that the nonsigning inventor was ever presented with the application for signature. The Manual of Patent Examining Procedure ("MPEP") states that

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

MPEP 409.03(d).

Petitioner must send a copy of the entire application, including the specification, claims and drawings, along with the oath or declaration and assignment to the nonsigning inventor before refusal can be alleged. If the application has in fact been presented to the inventor, the Petition must include this assertion in a statement of facts in support of the petition or directly in the petition. The assertion must be from a person having first hand knowledge of the presentation of the application. See MPEP 409.03(d).

As to item (2), an oath or declaration for the patent application in compliance with 37 CFR 1.63 and 1.64 has not been presented. Petitioner must provide an oath or declaration signed by a person to whom the inventor has assigned the invention, or who otherwise shows sufficient proprietary interest in the application, and include the title or position of the person signing on behalf of the company on the oath or declaration, along with the address and citizenship of the signor. An oath or declaration in compliance with 37 CFR 1.63 and 1.64 is REQUIRED. See MPEP 409.03(b).

As to item (5), Rule 47b applicant has failed to show or provide proof that Oberthur Gaming Technologies, Inc., (Hereinafter Oberthur), has sufficient proprietary interest in the subject matter to justify the filing of the application. Initially, it is brought to petitioner's attention that, in the absence of an assignment, the PTO will presume the named inventor to be the

owner of the rights, title, and interest to an application. See 37 CFR 3.73(a). This presumption may be overcome by proof that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

See Manual of Patent Examining Procedure ("MPEP") 409.03(f)

In the instant petitioner, Petitioner has failed to submit a copy of an assignment of the invention or a copy of an agreement to assign the invention. The MPEP further provides that

[a] proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state or foreign) would by weight of the authority in the jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of the same. The legal memorandum should be prepared and signed by an attorney-at-law familiar with the law of the jurisdiction involved. A copy (in the English language) of the statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patent Quarterly) relied on to demonstrate a proprietary interest should be made of record.

MPEP 409.03(f).

Petitioner must provide a copy of an assignment of the invention, a copy of an agreement to assign the invention¹, or a legal

¹Acceptable proof of an agreement to assign the invention would normally include a copy of an employment agreement between the inventor, and, in this instance, Oberthur, and a clear indication that the instant invention was made by the inventor during his employment with Oberthur.

memorandum signed by an attorney familiar with the law of the relevant jurisdiction stating that a court of competent jurisdiction would by the weight of authority in that jurisdiction award the title of the invention to Oberthur.

As to item (6), a statement that "the filing of the application is necessary to preserve the rights of the parties", is required.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
 Box DAC
 Washington, D.C. 20231

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
 2201 S. Clark Place
 Arlington, VA 22202

Telephone inquiries concerning this matter should be directed to the undersigned at (703) 305-0014.



Derek L. Woods
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Office of Petitions
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for Patent Examination Policy